

REMARKS

By the present amendment, claim 14 has been amended to incorporate the features of dependent claims 15 and 16, which have been canceled as well as additional features, as will be discussed below. Furthermore, by the present amendments, claims 19, 20 and 27 have been canceled, noting that the cancellation of the claims has been effected without prejudice or disclaimer of the subject matter thereof and the dependency of claims 20 - 26 has been changed with new dependent claims 28 - 32 being presented, as will be discussed below.

With regard to the amendment of claim 14, applicants note that this claim has been amended to recite the feature of obtaining at least one of (a) a difference image between the object image and the reference image (as previously recited in claim 15) and (b) a summation image of the object image and the reference image (as previously recited in claim 16). Furthermore, the manner of deciding a presence of a foreign matter has been clarified in that claim 14 now recites that such deciding is effected on a basis of at least one of (a) a difference between a distance between separate images of the foreign matter adjacent to each of the and a width of the repeated micro-miniature patterns on the difference image, (b) the summation image being made on the micro-miniature pattern and the foreign matter to be compared to a predetermined threshold, and (c) colors of the different images adjacent to each other of the foreign matter. That is, as described in connection with Figs. 12(a)-(d) at pages 32 - 34 of the specification of this application, and as more particularly described at page 33, line 16 to page 34, line 18, with respect to the difference image, when a difference is small between a distance, (see "d" in Fig. 12c, for example) between separate images of the foreign matter which are adjacent to each other and a width (see "L" in Fig. 12(a), for example) of the repeated micro-miniature

patterns, then it is determined that such is a killer or fatal defect as described in the paragraph bridging pages 33 and 34 of the specification. On the other hand, when the difference is longer or larger than such is determined to be a non-fatal defect, which features are now described in new dependent claim 29. Furthermore, claim 14 also describes the obtaining of a summation image of the object image and the reference image and the deciding a presence of foreign matter, it being determined on the basis of the summation image being made on the micro-miniature pattern and the foreign matter to be compared to a predetermined threshold as described in connection with Figure 18 at page 44, line 21 to page 44, line 14. Additionally, in accordance with the present invention, on the basis of a difference image, a foreign matter is determined on the basis of colors of the different images adjacent to each other as described in conjunction with Figure 15 at page 41, line 24 to page 42, line 17, for example. Thus, claim 14, as amended recites the three different manners of deciding the presence of foreign matter and new dependent claims 30 - 32 specifically recite one of the features of claim 14. Applicants submit that such features are not disclosed or taught in the cited art as will become clear from the following discussion.

The rejection of claims 14 - 17 and 19 - 20 under 35 USC 102(e) as being anticipated by Tsai et al (US 5,822,055) the rejection of claim 18 under 35 USC 103(a) as being unpatentable over Tsai et al (US 5,822,055) further in view of Addiego (US 5,917,588); the rejection of claims 21 - 24, 26 - 27 under 35 USC 103(a) as being unpatentable over Tsai et al (US 5,822,055) further in view of Yamaguchi et al (US 4,449,818); and the rejection of claim 25 under 35 USC 103(a) as being unpatentable over Tsai et al (US 5,822,055) in view of Addiego (US 5,917,588) and further in view of Yamaguchi et al (US 4,449,818); such rejections

are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC 103, As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching

or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Irrespective of the position set forth by the Examiner concerning the disclosure of Tsai et al, applicants note that assuming arguendo, that Tsai et al obtains a difference image between the object image and the reference image and the manner of deciding a presence of a foreign matter is based on a condition of the image obtained in accordance with the description in column 7, lines 39 - 53 of Tsai et al, it is readily apparent that Tsai et al provides no disclosure in the sense of 35 USC 102 or teaching in the sense of 35 USC 103 of the manner of deciding a presence of a foreign matter in accordance with feature (a), (b) or (c) as now recited

in claim 14 and the dependent claims of this application. That is, there is no disclosure or teaching in Tsai et al of deciding the presence of a foreign matter on the basis of (a) a difference between a distance between separate images of the foreign matter adjacent to each other and a width of the repeated micro-miniature patterns on the difference image (b) the summation image being made on the micro-miniature pattern and the foreign matter to be compared to a predetermined threshold or (c) colors of the different images adjacent to each other of the foreign matter. In fact, applicants submit that although the Examiner with respect to previous claim 16 contends that Fig. 5(b) of Tsai et al shows a difference image and that "a difference image is a summation image" (emphasis added) applicants submit that this position by the Examiner is contrary to accepted usage in the art of a summation image. In any event, as pointed out above, there is no disclosure or teaching in Tsai et al of the aforementioned features in the sense of 35 USC 102 or 35 USC 103 and claim 14 and the dependent claims patentably distinguish over Tsai et al and should be considered allowable thereover.

As to the combination of Tsai et al with Addiego and/or Yamaguchi et al, irrespective of the position set forth by the Examiner concerning the disclosure of Addiego and Yamaguchi et al, such patents do not overcome the deficiencies of Tsai et al, as pointed out above with respect to claim 14 and therewith the dependent claims of this application. Accordingly, applicants submit that all claims present in this application patentably distinguish over this proposed combination of references in the sense of 35 USC 103 and all claims should be considered allowable thereover.

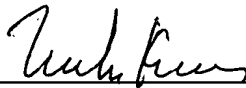
In view of the above amendments and remarks, applicants submit that claim 14 and its dependent claims patentably distinguish over the cited art and should now

be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 520.36449VX1), and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in dark ink, appearing to read 'Melvin Kraus', is written over a horizontal line.

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